



Attorney's Docket No.: 07039-298001

#1632
C. J. W.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Stephen James Russell et al. Art Unit : 1632
Serial No. : 09/667,947 Examiner : Shin-Lin Chen
Filed : September 22, 2000
Title : THERAPEUTIC METHODS AND COMPOSITIONS USING VIRUSES OF THE
RECOMBINANT PARAMYXOVIRIDAE FAMILY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

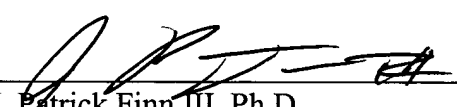
CHANGE IN INVENTORSHIP UNDER 37 C.F.R. § 1.48(b)

Applicants respectfully request that Urs Schneider, Roberto Cattaneo, and Anthea L. Murphy be removed as inventors under 37 C.F.R. § 1.48(b) on the above-indicated patent application. The claims for which Urs Schneider, Roberto Cattaneo, and Anthea L. Murphy are inventors have been canceled earlier during prosecution. Thus, Urs Schneider's, Roberto Cattaneo's, and Anthea L. Murphy's inventions are no longer being claimed in the instant application. A fee of \$130 is included herewith as required under 37 C.F.R. § 1.17(i).

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: June 18, 2004


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REPLY TO ACTION OF MARCH 18, 2004

In reply to the Office Action of March 18, 2004, Applicant submits the following remarks.

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June 18, 2004

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Judy Wasilkus

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REMARKS

Claims 27-37, 43, and 45-58 have been rejected and remain pending. In light of the following remarks, Applicants respectfully request reconsideration and allowance of claims 27-43 and 45-58.

Obviousness-type double patenting rejections

The Examiner rejected claims 27-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 17-21 of U.S. Patent No. 6,632,800.

While reserving the right to comment on the non-obviousness of claims 27-32, Applicants submit herewith a terminal disclaimer with respect to U.S. Patent No. 6,632,800. Thus, this rejection is moot.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 27-43 and 45-58 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleged that the phrase "said nucleic acid sequence is upstream of a nucleic acid encoding a viral polypeptide" in claims 27 and 43 is vague and renders the claims indefinite. The Examiner stated that it "is unclear whether the nucleic acid sequence is under the control of an endogenous viral promoter or a heterologous promoter, or there is no promoter sequence to direct the expression of said nucleic acid sequence."

Applicants respectfully disagree. A person having ordinary skill in the art would have had no problem understanding the meaning of claims 27 and 43. In addition, a person having ordinary skill in the art would have understood that the nucleic acid sequence located upstream of a nucleic acid encoding a viral polypeptide in a measles virus would, by virtue of its location, be capable of being expressed via a measles virus regulatory sequence. Taken together, the present claims are clear and unambiguous.

In light of the above, Applicants respectfully request withdrawal of the rejections of claims 27-43 and 45-58 under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 34-37, 43, and 45-53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,632,800 (the '800 patent).

Applicants respectfully submit that the '800 patent is not prior art. The '800 patent issued on October 14, 2003 and was filed on August 16, 2000, claiming priority to U.S. Provisional Application No. 60/149,168, filed August 17, 1999. In addition, the '800 patent lists Stephen James Russell and Kah Whye Peng as inventors. As indicated in the accompanying Change In Inventorship under 37 C.F.R. § 1.48(b), the inventors for the present application are Stephen James Russell and Kah Whye Peng. Thus, the '800 patent does not qualify as prior art under 35 U.S.C. § 102(e).


In light of the above, Applicants respectfully request withdrawal of the rejection of claims 34-37, 43, and 45-53 under 35 U.S.C. §103(a).

CONCLUSION

Applicants submit that claims 27-37, 43, and 45-58 are in condition for allowance, which action is requested. The Examiner is invited to call the undersigned agent at the telephone number below if such will advance prosecution of this application. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: June 18, 2004



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